

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 2672

In re Electronically filed by:
Patent Application of /elizabeth m. campbell tressler/
Sachiko Nishiura Date: August 5, 2008

Application No. 09/454,755

Confirmation No.: 4202

Filed: December 6, 1999

Examiner: Ryan R. Yang

“APPARATUS AND METHOD FOR
CONVERTING AN OBJECT DISPLAY
DESCRIPTION DOCUMENT”

REPLY TO SUPPLEMENTAL EXAMINER'S ANSWER DATED JUNE 9, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This communication is filed in response to the Supplemental Examiner's Answer mailed June 9, 2008 by Examiner Ryan R. Yang and is filed within the two-month time period for reply. Accordingly, no extension of time is believed to be necessary. In the event that any fees are due in connection with this communication, the Commissioner is authorized to charge any required fees or credit any overpayment to Deposit Account No. 50-1965.

I. **STATUS OF CLAIMS**

This is an appeal from the rejection set forth in the September 7, 2005 Office Action. Claims 1, 2, 4-11, 13-20 and 22-30 are pending. A copy of claims 1, 2, 4-11, 13-20 and 22-30 can be found in Section VIII of this Appeal Brief. Claims 3, 12, 21, and 31-33 were previously cancelled. Claims 1, 2, 4-11, 13-20 and 22-30 stand finally rejected. Appellants appeal the rejection of claims 1, 2, 4-11, 13-20 and 22-30.

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-2, 6-11, 15-18, and 28-30 are unpatentable under 35 U.S.C. § 102(e) as anticipated by Vyncke et al. (U.S. Patent No. 5,926,185).

B. Whether claims 19-20 and 24-27 are unpatentable under 35 U.S.C. § 103(a) as obvious over Vyncke et al.

C. Whether claims 4, 13, and 22 are unpatentable under 35 U.S.C. § 103(a) as obvious over Vyncke et al. and Cannon (U.S. Patent No. 5,559,950).

D. Whether claims 5, 14, and 23 are unpatentable under 35 U.S.C. § 103(a) as obvious over Vyncke et al. and Capps et al. (U.S. Patent No. 5,583,542).

III. ARGUMENT

Appellant replies to the June 9, 2008 Supplemental Examiner's Answer as follows.

As argued in Appellant's opening brief on appeal, Vyncke does not disclose combining a semi-transparent object with another object in a lower layer to form another object.

In an effort to overcome this omission of Vyncke, the Examiner has combined information from two distinct and incompatible embodiments of Vyncke. Nonetheless, neither embodiment discloses generating new objects by combining a semi-transparent source object with an object in a lower layer, as Appellant has previously argued.

In one embodiment cited by the Examiner, Vyncke discloses recombining the outlines (strokes) of objects with the same objects' fill under a specific and narrowly-prescribed set of conditions, which does not include any mention of the transparency of the objects involved: "The program checks ... if the pair has one object in front of the other with identical control points, i.e., the same number of control points in exactly the same locations. Moreover, the top object must be a stroke and not a fill, while the back object must not be a stroke." Col. 5, lines 32-36 (emphasis added). In another, separate embodiment cited by the Examiner, Vyncke discloses eliminating only those objects that are completely obscured by an opaque object. Col. 8, lines 27-57. However, in this embodiment Vyncke does not mention combining any objects, and in neither embodiment is any reference made to semi-transparent objects.

Thus, as previously argued, these two narrowly-focused embodiments do not disclose generating new objects by combining a semi-transparent source object with an object in a lower layer, as required by the claims. Instead, these embodiments are designed for specific and mutually-exclusive situations (recombining the outline and fill components of a single object

which have been separated during PostScript export, and eliminating completely-obscured objects) and Vyncke provides no guidance for practicing the embodiments together.

Appellant respectfully requests that a Notice of Allowance be issued in this case.

Respectfully submitted,

Dated: August 5, 2008

/thomas j. keating/

By: _____
Thomas J. Keating, Reg. No. 59,110
Phone: 608-257-7472

Docket: 204432-0019-US00

Michael Best & Friedrich LLP
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
Chicago, Illinois 60601
(312) 222-0800
(312) 222-0818 (fax)